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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,309	03/20/2001	Yuriy Grigorievich Shermolovich	514413-3870	2930

20999 7590 08/05/2003

FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER

FORD, JOHN M

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/812309

Applicant(s)

Shermolenich et al

Examiner

Jm Fork

Group Art Unit

1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 7-7-03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 25-40 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 25-40 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1624

Applicants' response of July 7, 2003, is noted.

The claims in the application are claims 25-40.

Claim 27 is rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph. N is never O. Perhaps the N should be a small case n.

Claims 25-28, 30, and 31—40 are rejected under 35 U.S.C. 103 as being unpatentable over U.S. Patent 5,360,806 to Toki et al. See col. 33. Compound 102 is reported in Chemical Abstracts, col. 121, entry 205212.

ACCESSION NUMBER: 1994:605212

DOCUMENT NUMBER: 121:205212

TITLE: Preparation of nicotinamides as pesticides

INVENTOR: Toki, Tedaaki; Koyanagi, Toru; Morita,  
Masayuki;  
Yoneda, Tetsuo; Kagimoto, Chiharu; Okada,  
Hiroshi

PATENT ASSIGNEE (S): Ishihara Sangyo Kaisha, Ltd., Japan

SOURCE: Eur. Pat. Appli., 39 pp.

CODEN: EPXXDW

DOCUMENT TYPE: Patent

LANGUAGE : English

Art Unit: 1624

This compound is closely analogous to ~~that~~ claimed here, for the same use as here.

The analogous compounds claimed here would be structurally obvious. See, *In re Dillon*, 919 F.2d at 696, 16 U.S.P.Q. 2d at 1904. See also *Deuel*, 51 F.3d at 1558, 34 U.S.P.Q. 2d at 1214 ("Structural relationships may provide the requisite motivation or suggestion to modify one compound to obtain another compounds. For example, one compound may suggest its homologs, because homologs often have similar properties, and, therefore, chemists of ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties, or merely to satisfy their production goals.

Other structural similarities have been found to support a prima facie case of obviousness. E.g., *In re May*, 574 F.2d 1082, 1093-95, 197 U.S.P.Q. 601, 610-11 (CCPA 1978) (stereo isomers); *In re Wilder*, 563 F.2d 457, 460, 195 U.S.P.Q. 426, 429 (CCPA 197) (adjacent homologs and structural isomers); *In re Hoch*, 428 F.2d 1341, 1344, 166 U.S.P.Q. 406, 409 (CCPA 1970) (acid and ethyl ester); *IN re Druey*, 319 F.2d 237, 240, 138 U.S.P.Q. 38, 41 (CCPA 1963) (omission of methyl group from pyrazole ring).

A compound need not be a homolog or isomer of a prior art compound in order to be susceptible to a rejection based on structural obviousness.

Thus, a difluorinated compound was held unpatentable over the prior art di chloro compound on the basis of analogical reasoning. Ex parte Wiseman (POBA 1953) 98 U.S.P.Q. 277.

Art Unit: 1624

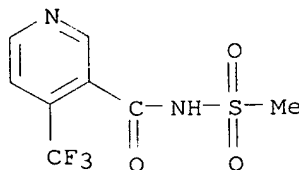
RN 158063-57-1 REGISTRY

CN 3-Pyridinecarboxamide, N-(methyl sulfonyl)-4-(trifluoromethyl)-

MF C8 H7 F3 N2 O3 S

SR CA

LC STN CA, CAPLUS, USPATFULL.



1 REFERENCES IN FILE CA (1967 TO DATE)

1 REFERENCES IN FILE CAPALUS (1967 TO DATE)

REFERENCE 1: 121:205212

Claim 29 is an extremely unusual structure for A, particularly with the D variations. This is a 35 U.S.C. 112, 1<sup>st</sup> paragraph rejection. What is the source of this multifaceted A starting material in claim 29.

John M. Ford:jmr

July 31, 2003

JOHN M. FORD  
PRIMARY EXAMINER